

RECEIVED
CENTRAL FAX CENTER
DEC 10 2009

Attorney Docket No.: 403104-A-01-US (Orbach)
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Julian James Orbach

Application No.: 10/810,526

Confirmation No.: 1176

Filed: 03/27/2004

Art Unit: 2617

For: Method and Apparatus For Incoming Call
Pause Notification

Examiner: Doan, Kiet M.

REPLY BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

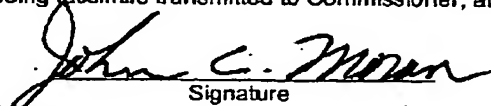
This Reply Brief is responsive to the Examiner's Answer mailed
10/23/2009.

This Reply Brief contains items under the following headings, as
recommended for reply briefs in M.P.E.P. § 1208:

- I. Status of Claims
- II. Grounds of Rejection to Be Reviewed on Appeal
- III. Argument

I. STATUS OF CLAIMS

The status of the claims is unchanged from that which was
previously stated in the Appeal Brief.

I hereby certify that this correspondence is being facsimile transmitted to Commissioner, at fax No. 571-273-8300,
on
12/10/2009
Data Being Faxed

Signature

Application No.: 10/117,162

II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The grounds of rejection to be reviewed on appeal are unchanged from that which was previously stated in the Appeal Brief

III. ARGUMENT

With Respect To Claims 12-15, 34-37, 56, and 60

Claim 12 recites the steps of answering, muting, and transmitting. The Examiner maintains that U.S. Patent Application Publication No. 2004/0198461 of D.J. Coombes (hereafter referred to as Coombes) discloses the recited step of answering and applicant disagrees. The recited step of answering is directed to a wireless handset that answers an incoming call upon detecting a predefined amount of movement in its physical location with the movement occurring after the incoming call is received and the handset is not involved in another call. In the (10) Response to Argument Section, the Examiner relies on Paragraphs [008], [0011], [0012] and [0016] as disclosing the recited step of answering.

Paragraph [008] does disclose a wireless handset automatically answering an incoming call received at an inconvenient time for the user and placing that call on hold. However, this paragraph discloses that the wireless handset performs these operations in response to receiving an affirmative indication from the user. The paragraph does not disclose or suggest what this affirmative indication is. Clearly, this paragraph does not disclose the recited step of answering.

Paragraph [0011] does not disclose or suggest the recited step of answering but rather discloses the recited step of transmitting a message to the caller to inform them of a delay. The Examiner states "Paragraph [0011] teaches how long the caller have to wait which read on the amount of movement occurring after the incoming call is received." This is

Application No.: 10/117,162

incorrect since the paragraph does not disclose any type of movement and does not imply that movement is necessary for the detailed operations. There is nothing in this paragraph to suggest that the user of the wireless handset has to move for the message to be transmitted to the caller. In addition, the operations of this paragraph do not occur until after the wireless handset has automatically answered the incoming call.

Paragraph [0012] clearly states "According to the invention, once the call alert is activated, the user selects (210) the auto-answered feature by, for example, pressing the designated button or soft key. In response to a user selecting the auto-answer feature option, the mobile communication device answers the incoming call..." The Examiner highlighted large portions of this paragraph but failed to highlight the portion that clearly discloses that the user manually activates the auto-answer feature by pressing the designated button or soft key. There is no disclosure or suggestion in this paragraph that the auto-answer feature is activated by movement. In addition, claim 12 does not recite any step concerning when the user may resume the call; hence, the highlighting of the last sentence of this paragraph is irrelevant.

The Examiner states "Paragraph [0016] teaches answering the incoming call at a location that is inconvenient or inappropriate to answer the call such as a meeting placing. Examiner asserts that the claim does not empirically define what or where the "location" should be. Therefore it is open to interpretation as an inconvenient location (e.g., church, meeting, etc.)". Applicant agrees with the Examiner's statement. This paragraph does teach that the wireless handset automatically answers an incoming call in response to being in an inconvenient location. However, this paragraph does not teach or disclose that the incoming call is answered by the wireless handset in response to a predefined amount of movement in the location of the wireless handset as detected by the

Application No.: 10/117,162

wireless handset which is what is clearly recited in claim 12. Claim 12 does not recite responding to a particular location but to a predefined movement. The claim does not empirically define what or where the "location" is since the location itself is irrelevant to the recited step of answering. This paragraph clearly does not disclose or suggest that the wireless handset is responding to movement but only that the wireless handset is responding to a location.

Therefore, the portions of Coombes relied on by the Examiner fail to disclose the step of answering as recited in claim 12. Since Coombes does not teach every aspect of the claimed invention, under MPEP §706.02, it cannot be the proper basis for a 35 U.S.C. §102 rejection of anticipation, and thus the Examiner has failed to establish a *prima facie* rejection.

Applicant respectfully submits that claim 12 is patentable under 35 U.S.C. §102(e) for these reasons. Also, applicant also submits that dependent claims 13-15 and 60 which are directly or indirectly dependent on claim 12 are patentable for at least the same reasons as claim 12.

In addition, applicant respectfully submits that claims 34-37 are patentable under 35 U.S.C. §102 (e) for the same reasons as claims 12-15.

Further, applicant respectfully submits that claim 56 is patentable under 35 U.S.C. §102 (e) for the same reasons as set forth with respect to claim 12.

With Respect To Claims 16-18, 20, 22, 38-40, 42 and 44

Claims 16-18, 20, and 22 are directly or indirectly dependent on claim 12. These claims were rejected under 35 U.S.C. §103 (a) as being

Application No.: 10/117,162

unpatentable over Coombes in view of U.S. Patent Application Publication No. 2002/0142756 of J.D. Rutledge, et al. (hereafter referred to as Rutledge). Independent claim 12 has been shown previously to be patentable over Coombes. The Examiner only cites Rutledge for "the steps of receiving a time specifying delay; and inserting the time into a predefined message". Applicant respectfully submits that claim 12 is patentable over Coombes in view of Rutledge. Also, claims 16-18, 20, and 22 are patentable for at least the same reasons as claim 12 over Coombes in view of Rutledge.

In addition, applicant respectfully submits that claim 34 is patentable for the same reasons as claim 12 under 35 USC §103 (a) over Coombes in view of Rutledge. Also, claims 38-40, 42 and 44 which are directly or indirectly dependent on claim 34 are patentable for at least the same reasons as claim 34.

With Respect To Claims 19, 21, 41, 43 and 57

Claims 19 and 21 were rejected under 35 U.S.C. §103 (a) as being unpatentable over Coombes in view of Rutledge and further in view of well known prior art. Claim 12 has been previously shown to be patentable over Coombes in view of Rutledge. Since the well known prior art was only cited for disclosing a text message, applicant respectfully submits that claim 12 is patentable under 35 U.S.C. §103 (a) over the cited references. In addition, applicant respectfully submits that dependent claims 19 and 21 which are directly or indirectly dependent on claim 12 are patentable for at least the same reasons as claim 12.

In addition, applicant respectfully submits that claim 34 is patentable under 35 U.S.C. over the cited references for the same reasons as claim 12. In addition, applicant respectfully submits that

Application No.: 10/117,162

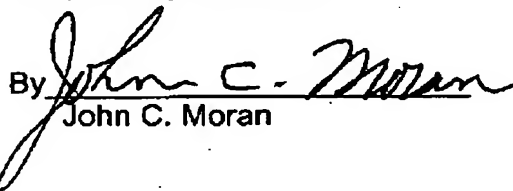
dependent claims 41 and 43 which are directly or indirectly dependent on claim 34 are patentable for at least the same reasons as claim 34.

Further, applicant respectfully submits that claim 56 is patentable under 35 U.S.C. over the cited references for the same reasons as claim 12. In addition, applicant respectfully submits that dependent claim 57 which is directly or indirectly dependent on claim 56 is patentable for at least the same reasons as claim 56.

Conclusion

Applicant respectfully request the board rule that the rejections of the claims are improper.

Respectfully submitted,

By 
John C. Moran

Attorney for Applicant
Reg. No.: 30,782

Date: 12/10/2009

Telephone No. (303) 450-9926